UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 09/831,622 | 05/11/2001 | Hiromu Sugino | 2001-0559A | 6107 |

513 7590 11/18/2002

WENDEROTH, LIND & PONACK, L.L.P.
2033 K STREET N. W.
SUITE 800
WASHINGTON, DC 20006-1021

| EXAMINER |
|---|
| ANDRES, JANET L |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1646 | |

DATE MAILED: 11/18/2002

12

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 09/831,622 | SUGINO, HIROMU | |
| | Examiner | Art Unit | |
| | Janet L Andres | 1646 | |

*-- The MAILING DATE f this communication appears on the cover sheet with the correspondenc address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) 1-30 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) 1-30 are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

## DETAILED ACTION

### *Election/Restrictions*

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-6, 15, 16, and 24, drawn to polypeptides and a method of use.

Group II, claim(s) 7-12, drawn to polynucleotides.

Group III, claim(s) 13 and 14, drawn to antibodies.

Group IV, claim(s) 17, drawn to binding agents.

Group V, claim(s) 18-25, drawn to screening methods.

Group VI, claim(s) 26-29, drawn to compounds that affect protein interactions.

Group VII, claim(s) 29 and 30, drawn to methods of treatment.

Claim 24 appears in two groups because it encompasses two inventions.

The inventions listed as Groups I-VII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The polypeptides of Group I and the polynucleotides of Group II do not share the same or corresponding special technical feature because Group II encompasses molecules identified by hybridization that cannot be used to make the polypeptides of Group I.

The polypeptides of Group I and the antibodies of Group III do not share the same or corresponding special technical feature because the antibodies and polypeptides are different molecules with different structures and different functional characteristics, and cannot be used together or interchangeably.

The polypeptides of Group I and the agents of Group IV do not share the same or corresponding special technical feature because the agents and polypeptides are different molecules with different structures and different functional characteristics.

The polypeptides of Group I and the methods of Group V do not share the same or corresponding special technical feature because the polypeptides have other uses, such as the generation of antibodies, and the screens can be performed using nucleic acids rather than polypeptides.

The polypeptides of Group I and the compounds of Group VI do not share the same or corresponding special technical feature because the polypeptides and effectors are different molecules with different structures and different functional characteristics.

The polypeptides of Group I and the methods of Group VII do not share the same or corresponding special technical feature because the polypeptides cannot be used in the methods.

The polynucleotides of Group II and the antibodies of Group III lack the same or corresponding special technical feature because they are different molecules with different structures and different functions and cannot be used together or interchangeably.

The polynucleotides of Group II and the agents of Group IV do not share the same or corresponding special technical feature because they are different molecules with different structures and different functions and cannot be used together or interchangeably.

The polynucleotides of Group II and the methods of Group V do not share the same or corresponding special technical feature because the methods can be performed without the polynucleotides and the polynucleotides have other uses, such as Northern blotting.

The polynucleotides of Group II and the compounds of Group VI do not share the same or corresponding special technical feature because they are different molecules with different structures and different functions and cannot be used together or interchangeably.

The polynucleotides of Group II and the methods of Group VII do not share the same or corresponding special technical feature because the polynucleotides cannot be used in the methods.

The antibodies of Group III and the agents of Group IV do not share the same or corresponding special technical feature because the binding agents need not be antibodies.

The antibodies of Group III and the methods of Group V do not share the same or corresponding special technical feature because the antibodies cannot be identified by these methods.

The antibodies of Group III and the compounds of Group VI do not share the same or corresponding special technical feature because they have different functions.

The antibodies of Group III and the method of Group VII do not share the same or corresponding special technical feature because the antibodies cannot be used in the methods.

The binding agents of Group IV and the methods of Group V do not share the same or corresponding special technical feature because the agents cannot be identified by these methods.

The binding agents of Group IV and the compounds of Group VI do not share the same or corresponding special technical feature because they have different functions.

The binding agents of Group IV and the methods of Group VII do not share the same or corresponding special technical feature because the binding agents cannot be used in these methods.

The methods of Group V and the compounds of Group VI do not share the same or corresponding special technical feature because the compounds can be identified in other ways, such as by purification.

The methods of Group V and the methods of Group VII do not share the same or corresponding special technical feature because they require different method steps and different reagent steps and have different goals and outcome measures.

The compounds of Group VI and the method of Group VII do not share the same or corresponding special technical feature because the compounds have other uses, such as the generation of antibodies, and the methods can be practiced with other compounds.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janet Andres, Ph.D., whose telephone number is (703) 305-0557. The examiner can normally be reached on Monday through Friday from 8:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, Ph.D., can be reached at (703) 308-6564. The fax phone number for this group is (703) 872-9306 or (703) 872-9307 for after final communications.

Communications via internet mail regarding this application, other than those under U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to **[yvonne.eyler@uspto.gov]**.

All Internet email communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark Office on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Janet Andres, Ph.D.

Patent Examiner
November 5, 2002